

REMARKS

Summary of Status of Amendments

Upon entry of this amendment, claim 8 will be amended. Claims 1-8, 20, 21 and 28 are all the claims pending in the application.

Claim 8 and 28 have been amended to even further clarify the claimed invention. Support for claim 8 may be found throughout the instant specification.

No new matter is added.

Suspension of Action under 37 C.F.R. §1.103(c)

Applicants have requested a Suspension of Action in the above-captioned application for a period of one (1) month. See, the Request for Continued Examination.

Rejection under §112 for Lack of Enablement

Claim 8 remains rejected under 35 USC §112, first paragraph, because the specification allegedly does not enable one of skill in the art to measure the activity of the cytokinin receptors recited in part (i) of claim 8. Claim 8 is rejected for reasons of record in the Office Action mailed July 14, 2005, which for brevity, is not repeated here.

Specifically, the Examiner appears to assert that the deletion, substitution or addition of one or a plurality of amino acids may completely eliminate the histidine kinase activity or introduce unknown function(s) to the cytokinin receptor.

In response, Applicants respectfully submit that the subject matter recited in claim 8 is enabled so that one of ordinary skill in the art would be capable of practicing Applicants' claimed invention without undue experimentation. As presented in the Amendment filed January 17, 2006, one of ordinary skill in the art would understand, following the guidance in

Applicants' specification, that the cytokinin receptor recited in claim 8 is a cytokinin receptor that "has cytokinin receptor activity". Part (i) of claim 8 does not encompass a protein having one or more amino acid deletions, substitutions or additions that eliminate the histidine kinase activity.

Accordingly, reconsideration and withdrawal of the rejection under 35 USC §112, first paragraph is respectfully requested.

Rejection under §102(a)

Claims 1-8, 20, 21, and 28 remain rejected under §102(a) as being anticipated by Inoue et al, *Nature* 409:1060-1063 (2001) (hereinafter "Inoue"). The Examiner asserts that although a Declaration under Rule 1.131 has been filed, the Declaration only contains the signatures of two of the three co-inventors.

In response, and as presented in Applicants' Amendment filed January 17, 2006, Inoue et al, *Nature* (2001) describes the work of the present inventors. The co-inventors of the claimed invention, Tatsuo KAKIMOTO, Tsutomu INOUE and Masayuki HIGUCHI, are each listed as co-authors of Inoue et al., *Nature* (2001). The remaining authors, Yukari HASHIMOTO, Motoaki SEKI, Masatomo KOBAYASHI, Tomohiko KATO, Satoshi TABATA and Kazuo SHINOZAKI are listed as co-authors of Inoue et al. as a general matter of courtesy but are not co-inventors of the claimed subject matter.

In addition, Applicants previously filed a Declaration under 37 CFR §1.132 on January 17, 2006, executed by Tatsuo Kakimoto, Tsutomu Inoue and Masayuki Higuchi, as well as three additional Declarations under 37 CFR §1.132 executed by: (1) Yukari Hashimoto; (2) Motoaki Seki, Masatomo Kobayashi, and Kazuo Shinozaki; and (3) Tomohiko Kato and Satoshi Tabata.

Accordingly, withdrawal of the rejection under § 102(a) is respectfully requested.

Rejection under §103(a)

Claims 1, 2, 6-8, 20, 21, and 28 are rejected under 35 U.S.C. § 103(a) as being obvious over Benfey et al. (U.S. Patent Application Publication 2002/0173017; hereinafter “Benfey”), in view of Iwamura et al., J. Medicinal Chem. 26:6 838-44 (1983) (hereinafter “Iwamura”).

As discussed above, the Examiner asserts that the Declaration under 1.131 is not persuasive because only the signatures of two of the three co-inventors is provided.

As indicated above, an unsigned Rule 1.131 Declaration is being submitted herewith to be executed by the inventor Tsutomu Inoue, with the signed Declaration to follow shortly.

During a telephone call to the Examiner on May 10, 2007 by Applicants’ representative, the Examiner stated that evidence as described on page 9 of the Office Action mailed May 2, 2006, would need to be submitted in order to show that the original submission to the journal Nature described the claimed invention before the date of the cited reference.

In response, Applicants submit an unexecuted Rule 1.132 Declaration from Tatsuo Kakimoto with an attached copy of an e-mail dated November 14, 2000 from an editor of the journal Nature to Dr. Kakimoto. The signed Declaration will follow shortly.

Applicants note that the email from the editor of the journal Nature to Dr. Kakimoto provides evidence that the present inventors had possession of the invention before November 29, 2000, in support of the Declaration under 1.131 filed April 15, 2005, to antedate the Benfey document. Applicants note that the e-mail contains comments of the editor and two referees on the original manuscript. The comments show that the present inventors had possession of the invention before November 29, 2000. For example, on page 3, line 27 to page 4, line 21 of the e-

mail, the first referee provided a summary of the works shown in the original manuscript and stated that “[t]his new work shows convincingly that a cytokinin receptor, like the ethylene receptors, is a receptor histidine kinase that operates through a phosphotransfer relay as in bacterial two-component systems” and that “[t]he work is well conducted with appropriate controls and finally provides the breakthrough in cytokinin research the field has been waiting for.”

Additionally, Applicants respectfully reiterate that the present invention was invented by Applicants before the filing of the Benfey provisional application 60/253,739 filed on November 29, 2000. As established by the attached Declaration Under 37 U.S.C. § 1.131, the present inventors are co-authors of the manuscript published as *Nature*, 409, 1060-1063 (2001). As indicated on the published article, the manuscript was received for publication by the journal *Nature* on October 16, 2000 (see page 1063, left column), before the filing date of the Benfey provisional application. Thus, the present invention was invented by Applicants prior to October 16, 2000, and invented prior Benfey’s earliest U.S. filing date. As such, Benfey is not prior art to this application.

Accordingly, withdrawal of the rejection under § 103(a) is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/918,508

Q65478

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: June 4, 2007